



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/081,257 | 02/22/2002 | Jeffrey W. Mankoff | 24124721.000008 | 2774 |
| 23562 7590 04/29/2008 BAKER & MCKENZIE LLP PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201 | | | | |
| EXAMINER CHAMPAGNE, DONALD | | | | |
| ART UNIT 3688 | | PAPER NUMBER | | |
| MAIL DATE 04/29/2008 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/081,257

Applicant(s)

MANKOFF, JEFFREY W.

Examiner

Donald L. Champagne

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-90 is/are pending in the application.
- 4a) Of the above claim(s) 72-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Withdrawal of Finality

1. Applicant's request filed on 28 February 2008 for reconsideration of the finality of the rejection mailed on 28 December 2007 is persuasive. The finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 53-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The distinction between "first enterprise" (e.g., claim 53 limitation "c)", second line) and "second enterprise" (e.g., claim 53 limitation "f)", second line) is indefinite.
4. The claimed distinction between first and second enterprises is interpreted to be based on ownership. Ownership is inherently indefinite because it is not concrete (predictable). The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). An enterprise can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership limitations cannot impart patentability.
5. Assume that a patent was granted with the claims limited to "a first enterprise" different from "a second enterprise". What would happen if one of these two entities bought the other? Does the patent suddenly become invalid? Further, does the patent regain its validity if the merged company is later broken up? And, what would happen is some third entity bought 50% of each the "first enterprise" and the "second enterprise"? Would the two enterprises now be "half different"?
6. The limitation "a second document source that is different from the first document source" (claim 58, limitation "e)", second line) is indefinite because "document source" is not clearly

Art Unit: 3688

defined. Since one “document source” is not clearly defined, it is impossible to determine how a second document source is different from the first. See para. 11 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 53-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US006915271B1).
9. Meyer et al. teaches (independent claim 53) a method of managing virtual documents (*promotional incentives*)¹ associated with one or more enterprises on behalf of a plurality of consumers, wherein a given virtual document comprises data associating it with one of the consumers and with one of the enterprises, the method comprising:
- a) establishing a network database (*member database 111*, col. 18 lines 35-38) on a network-connected computer (*member information computer 109*) said network database corresponding to a plurality of consumers, the network database having data records;
- b) receiving a first one of said virtual documents (*the clipped incentive*, col. 12 lines 35-39 and col. 36 lines 58-67) at said network-connected computer from a first document source (any first *incentive sponsor or issuer*, col. 16 lines 47-67, or *places* where incentives are found, col. 27 line 66 to col. 28 line 4, e.g., a *retailer web site*, col. 28 line 2 ; see para. 13 below);
- c) identifying (*registering for membership*, col. 16 lines 27-28) a consumer corresponding to the first received virtual document and identifying a first enterprise (*the incentive issuer*, col. 16 lines 47-67) associated with the first received virtual document;

¹ Meyer et al. uses this phrase as well as *promotion* and *incentive* interchangeably, although does also describe an *incentive* as a component of a *promotion*, col. 16 lines 17-18.

Art Unit: 3688

d) storing information from the first received virtual document within the network database in a first data record associated with the identified consumer (col. 36 lines 65-67), wherein the stored information includes the first enterprise identification stored in the first data record (col. 23 lines 14-15);

e) receiving a second one of said virtual documents (any *clipped incentive* other than the first) at said network-connected computer from a second document source (*email*, col. 28 line 4) that is different from the first document source;

f) identifying the consumer (verifying *membership*, col. 32 line 47 to col. 33 line 6) as corresponding to the second received virtual document and identifying a second enterprise (any *issuer* other than the first issuer) associated with the second received virtual document; and

g) storing information from the second received virtual document within the network database in a second data record associated with the identified consumer (col. 36 lines 65-67), wherein the stored information includes the second enterprise identification stored in the second data record (col. 23 lines 14-15).

10. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
11. The instant application contains no such clear definition for the phrase "document source". Indeed, the examiner could not find this phrase in the published application (US 20020120627A1). Examples of "content sources" are given in para. [0045] and examples of "data sources" are given at the end of para. [0071]. But these are example usages, and do not meet the requirements for a "clear definition." The examiner's interpretation of

Art Unit: 3688

"document source" is given below. Hence, the examiner is required to give the term "document source" its broadest reasonable interpretation, which the examiner judges to be any origin of a document, such as a *promotion author* (col. 16 lines 17-20) a certain *sponsor* or *issuer*, col. 16 lines 47-67, or certain *places* where incentives are found, col. 27 line 66 to col. 28 line 4.

12. Meyer et al. also teaches at the citations given above claims 54, 55, 59 (where the clipping process reads on emailing), 60, 61, 67 and 68.
13. Meyer et al. also teaches claims 56-58 (col. 7 lines 39-46, where "a website unassociated with the first or second enterprises or the consumer" is non-functional descriptive material and was not given patentable weight, MPEP § 2106.01); claims 62-66 (col. 5 lines 19-26 and col. 17 line 60 to col. 18 line 6); and claims 69-71, where a *datamart* is a categorization by enterprise (*promotion author*) identification (col. 17 lines 38-43 and col. 46 lines 44-60, where the two airlines identify the two virtual document sources).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
15. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3688

17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

26 April 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688